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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/352,192	07/12/1999	JEFFERY L. HILL	DYN-6D1-1	1908

28439 7590 03/04/2004

LAW OFFICES OF POTTHAST & ASSOCIATES  
2712 N. ASHLAND AVENUE  
CHICAGO, IL 60614-1106

EXAMINER
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NGUYEN, KIMBERLY D

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 03/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/352,192

Applicant(s)

HILL ET AL.

Examiner

Kimberly D. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Amendment*

1. Acknowledgement is made of Amendment filed 21 July 2003.

### *Double Patenting*

2. Claims 1-6 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 and 12-13 of U.S. Patent No. 5,494,544 (hereinafter Hill '544). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed invention is somewhat broader recitation of the patent '544. In claims 1-6 of the instant application, Applicants claim a method of verifying and validating the embossed information read from the embossed card to the prestored card information prior to insertion of the embossed cards into the card carrying mailing forms, etc., wherein the method of performing the above claimed invention is also recited in claims 1-3 and 12-13 of Hill '544. Although, the only difference between the present claimed invention and of the Hill '544 is the utilization of different terminologies and/or rephrasing of the terminologies, etc., the Examiner believes that the scope of claims 1-6 of the present application and claims 1-3 and 12-13 of Hill '544 are almost identical but differ only in terminology and/or the way the terminologies have been rephrased.
3. With respect to above discussion, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to utilize the teachings of claims 1-3 and 12-13 of Hill '544 to modify the method of performing the packaging of the embossed cards to perform the same functions, and to utilize the same terminologies as claimed by the present application. To the extent that the instant claims are broaden and therefore generic to the claimed invention of

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Hill '544, In re Goodman 29 USPQ 2d 2010 CAFC 1993, states that a generic claim cannot be issued without a terminal disclaimer, if a species claim has been previously been claimed in a co-pending application.

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

#### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Hill et al. (US 4,034,210; hereinafter "Hill '210").

Hill '210 teaches in an embossed card package production apparatus having means for producing cards from stored card information and means for inserting the cards into card carrying mailing forms, the improvement being a verification system, comprising:

means for determining when a card has been incorrectly prepared (i.e., the carrier information is compared by the machine with information on the cards... the appropriate number

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of correctly matched cards in their appropriate carrier (see col. 6, lines 57-65); pulling bad accounts...(see col. 3, lines 23-48)); and

means for preventing an incorrectly prepared card from being inserted into a carrier (such as, to reject those having an incorrect number of cards, pulling bad accounts after sealing and before mailing... see col. 3, lines 66+; col. 10, lines 40+; col. 12, lines 10-60; col. 13, line 35 through col. 14, line 51; col. 17, lines 27+).

### *Response to Arguments*

7. Applicant's arguments filed 21 July 2003 have been fully considered but they are not persuasive.

8. In response to Applicant's argument that "Reconsideration of the rejection of the claims 1-3 under the judicially created doctrine of obviousness-type double patenting. As previously noted, because of the prior restriction requirement, there is absolutely no proper basis for such a rejection. The Patent and Trademark Office **cannot** first claim that these claims are distinct for purposes of imposing a restriction requirement and thus force the applicant to limit his claims and cancel the nonelected claims and then later claim that these same claims are not distinct when a divisional application is filed on them. The rejection must be withdrawn for this reason alone, in addition to the other reasons previously asserted."; the Examiner respectfully submits that the obviousness-type double patenting rejection was based on the Hill '544 reference, whose application number is 36,657. The obviousness-type double patenting rejection was not based on the parent application 08/647,158, which this instant application is a divisional of. Therefore, the Examiner believes that "the obviousness-type double patenting rejection" cited in the Final Office action, dated on 28 January 2000, is still valid.

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9. In response to Applicant's argument that "...Accordingly, there is no possibility that the Hill reference can anticipate any of the claims under 35USC102(b). There is absolutely no support for the rejection of these claims on this basis, and withdrawal of the rejection on this basis is therefore respectfully requested. Withdrawal of the rejection is therefore respectfully requested."; the Examiner respectfully requests that the Applicant to further review Hill '210, given its broadest interpretation, the Examiner believes that Hill '210 still meets the claimed invention (see paragraph 6).

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly D. Nguyen whose telephone number is 571-272-2402. The examiner can normally be reached on Monday-Friday 7:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

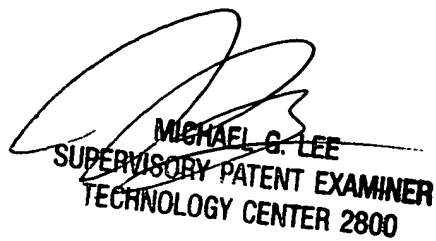
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25 February 2004



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